

REMARKS

After entry of the present amendment, claims 1-13, 18-23 and 29-35 will be pending in the present application. Claims 14-17, 24-28 and 36-42 have been canceled pursuant to the restriction requirement, and without prejudice to their presentation in another application. Claims 3-5, 10-13, 18, 21-23 and 29-30 have been amended, support for which can be found in the claims as filed.

The Office Action, apparently referring to the bibliography on pages 38-39 of the specification, reminds Applicants that a listing of references in the specification is not an information disclosure statement. The Office Action further states that references not listed on the accompanying form PTO-892 will not be considered. However, Applicants submitted a separate information disclosure statement in the present application on March 23, 2001, which was accompanied by a form PTO 1449 listing references AA-BI, along with copies of the same. Indeed, the present Office Action is accompanied by a copy of the form PTO-1449 submitted by Applicants.

Applicants do not understand the Office Action's rationale for denying considering their information disclosure statement. The presence of a bibliography in the specification is of no consequence where, as here, a proper information disclosure statement, Form PTO-1449 and copies of the listed references has been submitted. Accordingly, Applicants respectfully request consideration of the references on their Form PTO-1449 submitted in connection with their information disclosure statement.

The Abstract has been amended to address the concerns of the Office Action, and the specification has been amended to provide numbers for the equations on pages 4, 5, 7 and 8.

Claims 3-5, 10-13, 18, 21, 22, 29, 30 and 37 are objected to for various informalities. Claims 3, 4, 5, 10-12, 18, 21, 22, 29 and 30 have been amended to adopt the helpful suggestions of the Office Action. Claim 13 has been amended to depend from claim 11, thus addressing the Office Action's concerns. Claim 37 has been canceled, thus rendering the object to this claim moot.

Claims 3-7, 10-13, 21-23, 30-35 and 37 are rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants traverse the rejection and respectfully assert that those of skill in the art, reading the specification, would understand the term "substantially" recited in claim 3 to account for any numerical rounding performed in applying the

equations of claim 3 to determine values of X(p) and Y(p). Accordingly, Applicants respectfully assert that no correction is required, and therefore respectfully request withdrawal of this rejection under 35 U.S.C. §112, first paragraph.

Claim 23 is rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness on the basis that it is unclear to which equation the term “the equation” in line 2 of claim 23 refers. Claim 23 has been amended to insert the missing equation. Support for the amendment can be found on page 14 of the specification, at lines 7-10, and in originally filed claim 28. Accordingly, Applicants respectfully request that this rejection under 35 U.S.C. §112, second paragraph be withdrawn.

Claims 1, 2, 8, 9, 18-20 and 29 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Targowski et al., J. Fluorescence 1998 8(2) 121-128 (hereinafter, the “Targowski reference”). Applicants traverse the rejection and respectfully request reconsideration because the Targowski reference does not teach every feature recited in claims.

The Office Action asserts that the Targowski reference discloses the methods of the rejected claims, specifically citing pages 122-123 of the Targowski reference. However, it is settled law that for a reference to be anticipating, it must be enabling. The Targowski reference does not anticipate the present claims because it does not enable those of skill in the art how to perform the claimed methods.

The Office Action, citing Targowski at pages 122-3, states that the Targowski reference discloses a method of method for the extraction of true values of emission anisotropy and corrected values of total intensities from fluorescence intensities obtained for a sample under an applied hydrostatic pressure, comprising the steps of measuring polarized fluorescence intensities and then determining excitation and emission correction factors of claims 1 and 8, , and such methods wherein the true values of emission anisotropy and total intensities are obtained from said fluorescence intensities without performing a separate pressurized calibration experiment of claim 2 and 9. The Office Action further asserts that the Targowski reference teaches determining steady state fluorescence emission anisotropy of claim 18, the method for obtaining the true difference in polarized fluorescence intensities (D) from fluorescence intensities obtained for a sample under an applied hydrostatic pressure (*p*), comprising the steps of measuring polarized fluorescence intensities and then determining excitation and emission correction factors of claim 19, and such a method

wherein said true difference in polarized fluorescence intensities are obtained from said fluorescence intensities without performing a separate pressurized calibration experiment as recited in claim 20. Finally, the Office Action asserts that the Targowski reference teaches the computer readable storage medium of claim 29.

However, the Targowski reference does not provide any teaching *of how such methods are performed*. There is no guidance in the Tragowski reference of how to determine the excitation and emission correction factors as recited in independent claims 1, 8, 19 or 29. Those of skill in the art, reading the Targowski referecne, would simply not be able to perform the methods of the claims. Moreover, the Targowski reference specifically states at page 123, at the end of the first full paragraph, that the “direct” approach has been described “elsewhere”, citing to reference 15 of the Tragowski refrence.¹ Thus, the Targowski reference itself indicates that the information required to perform the determine the excitation and emission correction factors is not present therein. Accordingly, the Targowski reference does not anticipate the present claims. Applicants therefore respectfully request withdrawal of this rejection under 35 U.S.C. §102(b).

IX. Conclusion

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants’ undersigned representative at (215) 665-5548 if there are any questions regarding

¹ . This reference ultimately published after the priority date of the present application, and is listed as Reference V on the Form PTO-892 provided by the Examiner.

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PATENT

Applicants' claimed invention.

Respectfully submitted,



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Enclosure

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